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| APPLICATION NO.                        | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 09/783,553                             | 02/15/2001  | Hirotugu Satoh       | R2184.0095/P095     | 9369             |
| 24998                                  | 7590        | 03/07/2007           | EXAMINER            |                  |
| DICKSTEIN SHAPIRO LLP                  |             |                      | YIGDALL, MICHAEL J  |                  |
| 1825 EYE STREET NW                     |             |                      |                     |                  |
| Washington, DC 20006-5403              |             |                      | ART UNIT            | PAPER NUMBER     |
|  |             |                      | 2192                |                  |
| SHORTENED STATUTORY PERIOD OF RESPONSE |             | MAIL DATE            | DELIVERY MODE       |                  |
| 3 MONTHS                               |             | 03/07/2007           | PAPER               |                  |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |
|------------------------------|------------------------|---------------------|
|                              | 09/783,553             | SATOH, HIROTSUGU    |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |
|                              | Michael J. Yigdall     | 2192                |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 22 January 2007.

2a)  This action is **FINAL**.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)  Claim(s) 1-5 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5)  Claim(s) \_\_\_\_\_ is/are allowed.  
6)  Claim(s) 1-5 is/are rejected.  
7)  Claim(s) \_\_\_\_\_ is/are objected to.  
8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5)  Notice of Informal Patent Application  
6)  Other: \_\_\_\_\_.  
\_\_\_\_\_

## **DETAILED ACTION**

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 18, 2006 has been entered. Claims 1-5 are pending.

### ***Response to Arguments***

2. Applicant's arguments with respect to the limitations added to the claims (remarks, pages 7 and 9) have been considered but are moot in view of the new ground(s) of rejection, as set forth below with reference to Narin. Applicant's amendment necessitated the new ground(s) of rejection.

3. Applicant's arguments with respect to the combinations of references (remarks, pages 8 and 9) have been fully considered but they are not persuasive.

Applicant makes general allegations that "none of the cited references contain a suggestion or a motivation for their combination," that "none of the references sets forth a reasonable expectation of success in their combination," that "the Office action does not identify where a suggestion to combine the references exists or why a reasonable expectation of success of combining the references exists," and that "information contained in the current application is impermissibly used, in hindsight, to pick and choose features of the references to combine to arrive at the present invention" (remarks, page 8).

However, general allegations alone are not persuasive arguments. Applicant does not support these allegations with any analysis of the examiner's reasoning. The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988), and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Here, the examiner notes that teachings, suggestions or motivations to combine the teachings of the references, found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, are clearly set forth in the Office action.

Furthermore, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to Applicant's argument with respect to "the sheer number of disparate references applied by the Office Action" (remarks, page 9), Applicant is respectfully reminded that reliance on a large number of references in a rejection does not, without more, weigh against the obviousness of the claimed invention. See *In re Gorman*, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,097,814 to Mochizuki (art of record, "Mochizuki") in view of U.S. Patent No. 6,718,549 to Narin et al. (now made of record, "Narin") in view of U.S. Patent No. 6,094,723 to Tognazzini (art of record, "Tognazzini") and in view of U.S. Patent No. 6,535,911 to Miller et al. (art of record, "Miller").

With respect to claim 1 (currently amended), Mochizuki discloses an optical recording medium that is computer-readable and -writable (see, for example, column 5, lines 15-21, which shows a computer-readable optical recording medium, and column 9, line 56 to column 10, line 8, which shows that the medium is writable), which medium stores:

software to be distributed (see, for example, column 5, lines 29-35, which shows that the medium stores software to be distributed);

non-rewritable inherent ID information (see, for example, column 5, lines 29-35, which shows that the medium stores inherent ID information, and column 5, lines 56-67; which shows that the ID is permanent or non-rewritable);

a transmission program for transmitting the inherent ID information to a software distributor via a communication device (see, for example, steps S1 and S4 in FIG. 4, and column 7, lines 3-10, which shows that the ID stored on the medium is transmitted to a software distributor).

Mochizuki does not expressly disclose that the medium stores a version checking program for:

causing a version information of updated software to be transmitted to a computer, and causing the computer to compare the version information of the updated software to the software to be distributed.

However, like Mochizuki, Narin discloses software to be distributed (see, for example, column 3, lines 12-16). Narin further discloses a versioning engine that causes version information of updated software to be transmitted to a computer (see, for example, column 3, lines 16-27), and causes the computer to compare the version information of the updated software to the software to be distributed (see, for example, column 3, lines 28-29), so as to update out-of-date software to the current version (see, for example, column 3, lines 29-37).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to supplement the system of Mochizuki with a version checking program such as taught by Narin. It would have been obvious because one of ordinary skill in the art would have been motivated to update the software to be distributed to the current version.

Therefore, Mochizuki in view of Narin teaches or suggests that the medium stores a version checking program for:

causing a version information of updated software to be transmitted to a computer, and

causing the computer to compare the version information of the updated software to the software to be distributed.

Likewise, Mochizuki in view of Narin further teaches or suggests that the medium stores a storing program for causing updated software to be stored in a memory device of the computer (see, for example, Narin, column 3, lines 34-37, which shows that the versioning engine causes the updated software to be downloaded to the computer).

Mochizuki in view of Narin does not expressly disclose that the storing program is for causing updated software to be stored in the optical recording medium, wherein the updated software is stored in the memory device of the computer, and then the stored updated software is further stored in said optical recording medium.

However, like Mochizuki, Tognazzini discloses an optical recording medium that is computer-readable and -writable (see, for example, column 2, lines 8-17). Tognazzini further discloses downloading and applying supplemental information or updates to the optical recording medium through a computer (see, for example, column 5, lines 11-18). Such information is stored in a memory device of the computer, and then stored in the optical recording medium (see, for example, column 6, lines 8-17).

Similarly, Miller discloses updating the software recorded on an optical recording medium (see, for example, the abstract, and column 2, lines 4-5). Miller further discloses downloading the updated software and storing the updated software on a storage device of the computer, so as to resume any incomplete transmissions and ensure that all files are downloaded before applying the update (see, for example, column 5, lines 62-67, and column 7, lines 52-61).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to supplement the system of Mochizuki and Narin with a storing program for causing updated software to be stored in the optical recording medium, such as taught by Tognazzini. It would have been obvious because one of ordinary skill in the art would have been motivated to provide the ability to update a pre-recorded optical recording medium.

Furthermore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the system of Mochizuki, Narin and Tognazzini such that the updated software is stored in the memory device of said computer, and then the stored updated software is further stored in the optical recording medium, as suggested by Miller. It would have been obvious because one of ordinary skill in the art would have been motivated to provide the ability to resume any incomplete transmissions and ensure that all files are downloaded before storing the updated software in the optical recording medium.

Therefore, Mochizuki in view of Narin, Tognazzini and Miller teaches or suggests that the medium stores:

a storing program for causing updated software to be stored in a memory device of the computer and in the optical recording medium,

wherein the updated software is stored in the memory device of the computer, then the stored updated software is further stored in the optical recording medium.

With respect to claim 4 (currently amended), the rejection of claim 1 is incorporated, and Mochizuki further discloses further storing:

a computer information acquiring program for acquiring information of the computer (see, for example, column 6, lines 17-30, which shows obtaining a drive ID from the reproduction apparatus that is using the medium),

wherein the transmission program transmits the information of the computer, as well as the inherent ID information, to the software distributor (see, for example, steps S1, S2 and S4 in FIG. 4, and column 7, lines 3-10, which shows transmitting the inherent ID of the medium and the drive ID or information of the computer to the software distributor).

6. Claims 2, 3 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mochizuki in view of Narin in view of U.S. Patent No. 6,381,741 to Shaw (art of record, “Shaw”) in view of Tognazzini and in view of Miller.

With respect to claim 2 (previously presented), Mochizuki discloses an optical recording medium that is computer-readable and -writable (see, for example, column 5, lines 15-21, which shows a computer-readable optical recording medium, and column 9, line 56 to column 10, line 8, which shows that the medium is writable), which medium stores:

software to be distributed (see, for example, column 5, lines 29-35, which shows that the medium stores software to be distributed);

non-rewritable inherent ID information (see, for example, column 5, lines 29-35, which shows that the medium stores inherent ID information, and column 5, lines 56-67, which shows that the ID is permanent or non-rewritable).

Mochizuki does not expressly disclose that the medium stores a software updating program for:

causing a version information of updated software to be transmitted to a computer, causing the computer to compare the version information of the updated software to the software to be distributed.

However, like Mochizuki, Narin discloses software to be distributed (see, for example, column 3, lines 12-16). Narin further discloses a versioning engine that causes version information of updated software to be transmitted to a computer (see, for example, column 3, lines 16-27), and causes the computer to compare the version information of the updated software to the software to be distributed (see, for example, column 3, lines 28-29), so as to update out-of-date software to the current version (see, for example, column 3, lines 29-37).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to supplement the system of Mochizuki with a software updating program such as taught by Narin. It would have been obvious because one of ordinary skill in the art would have been motivated to update the software to be distributed to the current version.

Therefore, Mochizuki in view of Narin teaches or suggests that the medium stores a software updating program for:

causing a version information of updated software to be transmitted to a computer, causing the computer to compare the version information of the updated software to the software to be distributed.

Mochizuki further discloses reproducing the software based on an authentication judgment result of the inherent ID information (see, for example, steps S1, S4, S8 and S9 in FIG. 4), and Narin further discloses updating the software (see, for example, column 3, lines 34-37), but Mochizuki in view of Narin does not expressly disclose that the software updating program

is for rewriting and updating the software in accordance with update software transmitted from a software distributor via a communication device based on an authentication judgment result of the inherent ID information.

However, Shaw discloses an updater (see, for example, column 4, lines 44-49) for rewriting and updating software with updated code transmitted from a distributor (see, for example, column 5, lines 3-13), based on an authentication judgment result (see, for example, column 4, lines 34-42, which shows comparing a digital signature before beginning the update), after first transmitting ID information (see, for example, column 4, lines 13-18). Shaw further discloses that the updater securely updates the data by performing integrity tests and confirming that the update is trustworthy (see, for example, column 1, line 66 to column 2, line 10).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to supplement the system of Mochizuki and Narin with a software updating program for rewriting and updating the software in accordance with update software transmitted from a software distributor via a communication device based on an authentication judgment result of the inherent ID information, such as taught by Shaw. It would have been obvious because one of ordinary skill in the art would have been motivated to provide the ability to securely update the software by performing integrity tests and confirming that the update is trustworthy.

Therefore, Mochizuki in view of Narin and Shaw teaches or suggests that the medium stores a software updating program for:

rewriting an updating the software in accordance with update software transmitted from a software distributor via a communication device based on an authentication judgment result of the inherent ID information.

Mochizuki in view of Narin and Shaw further teaches or suggests that the software updating program is for causing updated software to be stored in a memory device of the computer (see, for example, Narin, column 3, lines 34-37, which shows that the versioning engine causes the updated software to be downloaded to the computer).

Mochizuki in view of Narin and Shaw does not expressly disclose that the software updating program is for causing updated software to be stored in the optical recording medium, wherein the updated software is stored in the memory device of the computer, and then the stored updated software is further stored in the optical recording medium.

However, like Mochizuki, Tognazzini discloses an optical recording medium that is computer-readable and -writable (see, for example, column 2, lines 8-17). Tognazzini further discloses downloading and applying supplemental information or updates to the optical recording medium through a computer (see, for example, column 5, lines 11-18). Such information is stored in a memory device of the computer, and then stored in the optical recording medium (see, for example, column 6, lines 8-17).

Similarly, Miller discloses updating the software recorded on an optical recording medium (see, for example, the abstract, and column 2, lines 4-5). Miller further discloses downloading the updated software and storing the updated software on a storage device of the computer, so as to resume any incomplete transmissions and ensure that all files are downloaded before applying the update (see, for example, column 5, lines 62-67, and column 7, lines 52-61):

It would have been obvious to one of ordinary skill in the art at the time the invention was made to supplement the system of Mochizuki, Narin and Shaw with a software updating program for causing updated software to be stored in a memory device of the computer and in

the optical recording medium, such as taught by Tognazzini. It would have been obvious because one of ordinary skill in the art would have been motivated to provide the ability to update a pre-recorded optical recording medium.

Furthermore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the system of Mochizuki, Narin, Shaw and Tognazzini such that the updated software is stored in the memory device of the computer, and then the stored updated software is further stored in the optical recording medium, as suggested by Miller. It would have been obvious because one of ordinary skill in the art would have been motivated to provide the ability to resume any incomplete transmissions and ensure that all files are downloaded before storing the updated software in the optical recording medium.

Therefore, Mochizuki in view of Narin, Shaw, Tognazzini and Miller teaches or suggests that the medium stores a software updating program for:

causing updated software to be stored in a memory device of the computer and in the optical recording medium,

wherein the updated software is stored in the memory device of the computer, then the stored updated software is further stored in the optical recording medium.

With respect to claim 3 (currently amended), the elements recited in the claimed optical recording medium correspond to those recited in claims 1 and 2 (see the rejections of claims 1 and 2 above).

With respect to claim 5 (currently amended), the steps recited in the claimed method correspond to the elements recited in claims 1 and 2 (see the rejections of claims 1 and 2 above).

***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure (see the attached Notice of References Cited).

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J. Yigdall whose telephone number is (571) 272-3707. The examiner can normally be reached on Monday through Friday from 7:30am to 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tuan Q. Dam can be reached on (571) 272-3695. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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